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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,997	04/24/2000	Ganesh Venkataraman	M0656/7055 (HCL)	7686
23628	7590	11/05/2003	EXAMINER	
WOLF GREENFIELD & SACKS, PC FEDERAL RESERVE PLAZA 600 ATLANTIC AVENUE BOSTON, MA 02210-2211			SMITH, CAROLYN L	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/557,997	Applicant(s) VENKATARAMAN ET AL.	
	Examiner Carolyn L Smith	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 and 38-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' election with traverse of Group IV (claims 36-37), filed 8/8/03, is acknowledged. Claims 1-35 and 38-53 are withdrawn from consideration as being drawn to non-elected Groups.

Applicants' traversal is on the grounds that a search and examination of all the pending claims would not require an undue search burden as Groups are directed to the same class and subclass.

The applicants' request to examine all claims was found unpersuasive because of the following reasons (summarized from the restriction paper):

The invention Groups I-IV are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the data structure of Group I may be utilized in several distinct usages as needed in Group II for a method of determining whether properties of a query sequence match properties of a polymer, for use in a database as in Group III, in a method for determining whether complete building blocks of a query sequence match complete building blocks of a polysaccharide as in Group IV, or alternatively, in genetic disorder studies. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

The requirements are still deemed proper and are therefore made FINAL.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The present title is directed to a system and method for notating polymers, whereas in contrast the elected claim is specifically directed to a method for determining whether complete building blocks of a query sequence of chemical units match complete building blocks of a polysaccharide.

The corrected drawings, filed 8/8/03, have been approved by the drafts person.

The Information Disclosure Statement, filed 2/10/2003, has been considered.

Claims herein under examination are 36 and 37.

Specification

The abstract of the disclosure is objected to because it exceeds 150 words and is therefore too long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112, First Paragraph

Claims 36 and 37 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. As written, the claims appear to lack any physical result performed outside of a computer.

As stated in MPEP § 2106, (IV)(2)(b), to be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would

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have been known to a skilled artisan (discussed in MPEP § 2106 (IV)(2)(b)(i)), or (B) be limited to a practical application within the technological arts (discussed in MPEP § 2106 (IV)(2)(b)(ii)).

As stated in MPEP § 2106 (IV)(2)(b)(i), the independent physical acts may be post- or pre-computer processing activity as described below:

A process is statutory if it requires physical acts to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure. *Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8. Thus, if a process claim includes one or more post-computer process steps that result in a physical transformation outside the computer (beyond merely conveying the direct result of the computer operation), the claim is clearly statutory.

Another statutory process is one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data (*In re Gelnovatch*, 595 F.2d 32, 41 n.7, 201 USPQ 136, 145 n.7 (CCPA 1979) (data-gathering step did not measure physical phenomenon); *Arrhythmia*, 958 F.2d at 1056, 22 USPQ2d at 1036), where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities. *Schrader*, 22 F.3d at 294, 30 USPQ2d at 1459 citing with approval *Arrhythmia*, 958 F.2d at 1058-59, 22 USPQ2d at 1037-38; *Abele*, 684 F.2d at 909, 214 USPQ at 688; *In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982).

As stated in MPEP § 2106 (IV)(2)(b)(ii), the computer-related process may be limited to a practical application in the technological arts as described below:

There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036.

Claims 36 and 37 do not fulfill either of these statutory requirements and are therefore rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

Claims 36 and 37 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. As written, the claims appear to be directed to a method that merely manipulates numbers, abstract concepts or ideas, or signals representing any of the foregoing.

As stated in MPEP § 2106, (IV)(B)(1), If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

In practical terms, claims define nonstatutory processes if they:

- consist solely of mathematical operations without some claimed practical application (i.e., executing a “mathematical algorithm”); or
- simply manipulate abstract ideas, e.g., a bid (*Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59) or a bubble hierarchy (*Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759), without some claimed practical application.

Claims 36 and 37 do not fulfill any of these statutory requirements and are therefore rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter.

Claims Rejected Under 35 U.S.C. § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 36 (lines 2, 5, 8, 15, and 16) recites the phrase “*complete* building blocks” which is vague and indefinite. It is unclear what is considered to be a complete building block as opposed to an incomplete building block. For example, on page 6, lines 19-24, of the specification states a polysaccharide can include a monomeric building block or a dimeric building block. As such, it is unclear if applicants consider both or only one of these types of building blocks to be complete for a polysaccharide. This same issue of what is considered a complete building block also applies to the “complete building blocks of the query sequence” (claim 36, lines 5 and 15) which can be composed of a variety of polymers. Claim 37 is also rejected due to its dependency from claim 36.

Claim Rejections – 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Claverie et al. (Computers Chem., Vol. 17, No. 2, pp. 191-201).

Webster's NewWorld Medical Dictionary defines deoxyribonucleic acid (DNA) to contain deoxyribose which is defined to be a sugar component (monosaccharide). As the exact definition of polysaccharide is not specified in the instant specification, DNA can reasonably be interpreted to be a "polysaccharide" as it contains multiple monosaccharides. Due to the unclarity of "*complete* building blocks" (lines 1 and 2), these blocks are reasonably interpreted to be any type of material found in the query or "polysaccharide". In this manner, these building blocks are reasonably interpreted to include the nucleotides of a DNA molecule.

Claverie et al. disclose a method of using algorithms on computers (reasonably interpreted to be a computer-readable medium) to make comparisons between query sequences and database sequences (abstract and page 191, col. 1, second paragraph). Claverie et al. disclose database comparisons include genes and cDNA (page 191, col. 2, first paragraph). In figure 3B, Claverie et al. disclose a query sequence in a data structure containing values represented by n's (masked region) as well as As, Ts, Gs, and Cs representing unmasked regions. Figure 3A contains "EST1591 (210 nucleotides) human brain" wherein EST1591 is reasonably interpreted to be an identifier, while "(210 nucleotides)" and "human brain" are reasonably interpreted to be other fields giving information. Figure 3B lists sequence matches to the query which also contain names (identifiers) as well as other fields including numerical values. The mask in Figure 3B is directed toward Alu elements which are stored in the form of "n"s in the field representing the sequence (Figure 3B, lines 3-5). "Binary operation" is not succinctly

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defined in the instant specification. As Webster's II New Riverside Dictionary defines "binary" to be composed of two different parts, Figure 3B lists the results of two different results based on operations performed during the sequence comparison. In particular these two operations performed include the score (third field from left) and the probability (fourth field from left) with values resulting from the masking procedure. The sequences listed in Figure 3B represent sequences that match between the query sequence and other sequences.

Thus, Claverie et al. anticipate the instant invention.

Conclusion

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Thursday from 8 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

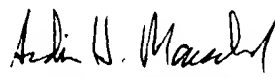
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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

October 22, 2003


ARDIN H. MARSCHEL
Legal Instruments Examiner